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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,342	12/09/2004	Bernd Lang	PTB-4750-23	2905
23117 7590 05/27/2010 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
HICKS, VICTORIA J				
ART UNIT		PAPER NUMBER		
3772				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,342

Applicant(s)

LANG ET AL.

Examiner

VICTORIA HICKS

Art Unit

3772

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 and 45-60 is/are pending in the application.
- 4a) Of the above claim(s) 45-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the amendment filed on February 16, 2010.

Claims 1-24 and 32-44 were cancelled by Applicant. Claims 45-60 were added by Applicant.

Election/Restrictions

Newly submitted claims 45-60 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 45-60 are directed to a mask pad and mask assembly which include a side wall, a feature which was not present in the originally claimed invention.

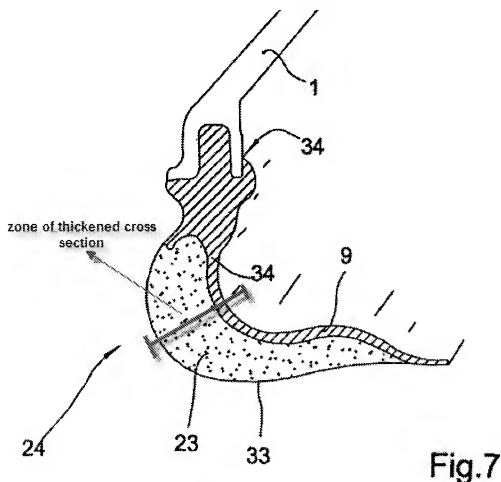
Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant failed to amend the abstract in order to overcome the examiner's previous objection to the specification. The objection to the specification has therefore been maintained.

Applicant's arguments filed 2/16/10 regarding the rejection of the claims under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered but they are not persuasive. In response to Applicant's argument that the examiner's rejection of claims 1, 3-12, 26-29 and 31-36 under 35 U.S.C. 102(b) over Lang et al. is not valid because the rejection points to two embodiments of the invention, the examiner points out that the structures disclosed by Lang et al. in Figures 1a, 1e and 7 are taught to be used together. This is taught by Lang et al. in [0022], [0029] and [0030], for instance. In response to Applicant's argument that Lang et al. does not teach a closed pocket, the examiner notes that the term *closed* can be defined to be "having or forming a boundary or barrier." The pocket (34) taught by Lang et al. forms a boundary or barrier, as is therefore, a closed pocket. In response to Applicant's argument that Lang et al. does not disclose a forehead pad, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Lang et al. teaches a pad structure that is **capable of** being used on the forehead of a user. In response that Lang et al. fails to teach a stem structure as recited in claims 31 of the present invention, the examiner notes that in Figures 4 and 7 Lang et al. teaches that the base body (1) has a coupling portion (34) for fixing the forehead pad (24) to a forehead support device (1) and a stem portion (9) for radially yieldingly mounting a forehead contact portion provided (24) for bearing against a forehead surface, wherein the forehead pad (24) has a zone of thickened cross-section and in the zone is provided

with a gel or foam material (23). The structure 9 taught by Lang et al. constitutes a "stem" in that it is a long, slender part. In response to Applicant's argument that Lang et al. does not teach the forehead pad having a zone of thickened cross section, it is clear from Figure 7 of Lang et al. that the forehead pad (24) has a zone of thickened cross-section and in the zone is provided with a gel or foam material (23). Please see the annotated copy of Figure 7 of Lang et al. that is provided below.



In response to Applicant's argument that that rejection of claims 2 and 30 under 35 U.S.C. over Lang et al. in view of US 2009/0178679 Lithgow et al. is traversed "as

Lithgow et al. qualifies under 35 U.S.C. 102(e) and is commonly owned with Lang et al., thus making it ineligible for combination with Lang et al. under section 103(a), per MPEP 706.02(k)," the examiner respectfully disagrees. It is unclear if Applicant is referring to the Lang et al. patent (EP 1099452) or the present invention by Lang et al. in this argument. Applicant seems to be arguing that the Lang et al. prior art reference Lang et al. (EP 1099452) and the present application by Lang et al. are commonly owned. However, in order for a reference to be unavailable as prior art, the reference must be copending with the present invention and commonly assigned, which is not the case with Lang et al. (EP 1099452) and the present application by Lang et al. If Applicant means that the Lithgow et al. reference is commonly owned and unavailable as prior art, the examiner notes that Lithgow et al. is not assigned and Applicant has not provided any evidence to indicate that Lithgow et al. is assigned. Applicant's argument is therefore, not persuasive. Please refer to MPEP 706.02(k).

Specification

1. The abstract of the disclosure is objected to because the abstract contains legal phraseology ("comprising") which should be removed. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 26-29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al. (EP 1099452).

In regards to claim 26, Lang et al. teaches in Figures 1a and 1e a mask pad (1) with a receiving opening (n) which in the position of application of the breathing mask coincides at least with the nose and/or mouth opening region of a user of the mask, and a sealing lip (4, 9, 23) that extends around the receiving opening (n) and which in the application position fits on the surface of the face of the user of the mask. In [0041] Lang et al. teaches that the sealing lip (4, 9, 23) is formed from an elastomer (elastomeric) material. In [0041] and Figure 7 Lang et al. teaches at least one zone of thickened cross-section (23, 33) is provided in the inner region of the mask pad (24) and that the mask pad (24) material of the zone of thickened cross-section (23, 33) has gel-like material properties, wherein the zone of thickened cross-section (23, 33) includes a gel-like cross-linked elastomer body inserted into a fixing structure in the internal space of the mask pad device.

In regards to claim 27, Lang et al. substantially teaches the apparatus of claim 26 (see rejection of claim 26 above). Lang et al. teaches in [0037] and Figure 3b that the gel-like crosslinked body (9) is of a horse-like configuration and in the application position is capable of extending over the bridge of the nose of the user of the mask.

In regards to claim 28, Lang et al. substantially teaches the apparatus of claim 26 (see rejection of claim 26 above). Lang et al. teaches in [0037] and Figures 1, 1a and

1e that the gel-like crosslinked body (9) is of a ring-like configuration, following the sealing lip (4, 9, 23), extending around a mouth and/or nose opening.

In regards to claim 29, Lang et al. teaches in Figures 1a and 1e a mask pad (1) with a receiving opening (n) which in the position of application of the breathing mask coincides at least with the nose and/or mouth opening region of a user of the mask, and a sealing lip (4, 9, 23) that extends around the receiving opening (n) and which in the application position fits on the surface of the face of the user of the mask. In [0041] Lang et al. teaches that the sealing lip (4, 9, 23) is formed from an elastomer (elastomeric) material. In Figure 7 Lang et al. teaches at least one closed (having or forming a boundary or barrier) receiving pocket portion (34) and provided in the receiving pocket portion (34) is a cushion body (23), wherein the configuration of the pocket portion (34) is established such that the sealing lip (4, 9, 23) device defined a skin contact zone in which the sealing lip (4, 9, 23) device can be urged against the surface of the face by the cushion body (23). In [0041] Lang et al. teaches that the cushion body is formed of a gel material.

In regards to claim 31, Lang et al. teaches in [0025] that the forehead pad base body (1) is made from an elastomer material. In Figures 4 and 7 Lang et al. teaches that the base body (1) has a coupling portion (34) for fixing the forehead pad (24) to a forehead support device (1) and a stem portion (9) for radially yieldingly mounting a forehead contact portion provided (24) for bearing against a forehead surface, wherein the forehead pad (24) has a zone of thickened cross-section and in the zone is provided with a gel or foam material (23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Lang et al. (EP 1099452) in view of Lithgow et al. (US publication
2009/0178679).

In regards to claim 30, Lang et al. substantially teaches the apparatus of claim 29 (see rejection of claim 29 above). Lang et al. does not teach that the cushion body is subdivided into segments. However, Lithgow et al. teaches in [0114] and Figure 2B an analogous device in which the cushion body (14) is subdivided into segments (24, 26, 28). It would have been obvious to one having ordinary skill in the art at the time of invention to modify the cushion body taught by Lang et al. with the segments taught by Lithgow et al. because this element is known to enable the contact force applied to sensitive region's on the patient's face to be minimized, as Lithgow et al. teaches in [0114].

4. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Lang et al. (EP 1099452) in view of Le Mitouard (US patent 5,429,683).

In regards to claim 25, Lang et al. teaches in Figures 1a and 1e a mask pad (1) with a receiving opening (n) which in the position of application of the breathing mask coincides at least with the nose and/or mouth opening region of a user of the mask, and a sealing lip (4, 9, 23) that extends around the receiving opening (n) and which in the application position fits on the surface of the face of the user of the mask. In [0041] Lang et al. teaches that the sealing lip (4, 9, 23) is formed from an elastomer (elastomeric) material. In [0041] and Figure 7 Lang et al. teaches at least one zone of thickened cross-section (23, 33) is provided in the mask pad (24). Lang et al. does not teach that the mask pad material of the zone of thickened cross-section is foamed in such a way that in the region of the zone of thickened cross-section the mask pad forms a foam cushion. However, Le Mitouard teaches in Figure 3 and column 3, lines 29-32 an analogous device in which the mask pad (6) material of the zone of thickened cross-section (6a) is foamed in such a way that in the region of the zone of thickened cross-section (6a) the mask pad (6) forms a foam cushion. It would have been obvious to one having ordinary skill in the art at the time of invention to modify the zone of thickened cross-section taught by Lang et al. with the foam cushion taught by Le Mitouard because this element is known to provide a comfortable cushioning surface for the user.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA HICKS whose telephone number is (571)270-7033. The examiner can normally be reached on Monday through Thursday, 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. H./
Examiner, Art Unit 3772
5/20/10

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772